

**REMARKS**

Claims 7, 16, 18, 19, 25, 27, 29, 30, 34-36, 47, 59, 60, 63-65, 67, 83, 84, 87-89, 91, 98, 99, 102-104, 106, 110, 114, 115, 118-120, 122, 124, 131, 134, 135, 138-140, 142-144, 148, 156, 157, 160-162, 164, 169, 176, 183, 190, 197, 204, 216, 217, 220-222, and 224 are either allowed or indicated by the Examiner to recite allowable subject matter. The remaining claims stand rejected either under 35 U.S.C. § 102 (b) as being anticipated by US Patent No. 6,137,095 Kashimoto et al. (Kashimoto) or under 35 U.S.C. § 103 (a) as being obvious over Kashimoto in view of another reference (US Pat. No. 4,237,731 to Dehn et al, US Pat No. 5,360,965 to Ishii et al., JP 4-347417 to Watanabe et al.). All of the claims are further rejected under 35 U.S.C. 112 as failing to distinctly claim and particularly point out the subject matter which is regarded as the invention. Citing MPEP § 2173.05(n) the Examiner asserts that the applicants have presented an unreasonable number of claims.

*The § 102 and 103 § Rejections*

Applicants have cancelled without prejudice or disclaimer claims rejected either under 35 U.S.C. § 102 or 35 U.S.C. § 103 (claims 12, 16, 20 and 33) and therefore no comment is believed to be necessary as to those cancelled claims. The cancellation of claims rejected under 35 U.S.C. § 102 or 35 U.S.C. § 103 in no way evidences any intent on applicants' part to abandon the subject matter of those claims and, indeed, applicants may choose to pursue claims of lesser, greater, or similar scope and subject matter in applications related to the present application (e.g. a continuation reissue application).

It is to be stressed that applicants consider there still to be numerous deficiencies in the Examiner's examination of the claims. In brief, the Examiner at least has failed to consider limitations of certain of applicants claims, and, in addition, as to claims rejected under 35 U.S.C. § 103 has failed to establish that there is motivation to modify the primary reference.

Applicants reserve the right to further point out deficiencies in the Examiner's rejections under 35 U.S.C. §§ 102 and 103 in an application related to the present application. Further, the cancellation of claims rejected under 35 U.S.C. §§ 102 and 103 in no way implies that applicants concede that the primary reference cannot be removed as a reference under 35 U.S.C. § 102(e)

In spite of the perceived deficiencies in the examination, applicants elect, rather than file an appeal in the present application, to cancel claims preserving the option for broader claims via a continuation. Applicants are desirous of avoiding the sometimes extensive prosecution delays associated with the appeals process in the United States Patent and Trademark Office.

*The Allowed Claims and Objected-To Claims Describing Allowable Subject Matter*

New claims 225-329 are all believed to recite subject matter which the Examiner has indicated to be allowable. New independent claim 225 is similar in scope to allowed independent claim 25, new independent claim 239 is similar in scope to allowed independent claim 27, new independent claim 253 is similar in scope to allowed independent claim 29, new independent claim 261 is similar to allowed claim 34, new claim 274 is similar in scope to allowed claim 35, new independent claim 285 is similar in scope to allowed claim 36, new independent claim 289 is believed to recite subject matter indicated to be allowable by, for example, the Examiner's indication that claims 63, 87, 102, 118, 138, 160, and 220 are allowable, new independent claim 299 is believed to recite subject matter indicated to be allowable by, for example, the Examiner's indication that claims 47, 110, 131, 148, 169, 176, 183, 190, 197, and 204 are allowable, while new claim 308 is believed to recite subject matter indicated to be allowable by, for example, the Examiner's indication that claims 67, 91, 106, 122, 142, 164, and 224 are allowable. The Examiner will note that as between allowed claims 25, 27, 29, 34, 35, 36 and new claims 225, 239, 253, 261, 274, and 285, certain limitations including limitations not accorded

patentable weight by the Examiner have been removed. In such instances the removal of limitations by the applicants will not be construed as an admission that the Examiner was correct in not according patentable weight to the removed limitations. Regarding the application's dependent claims, all of the dependent claims are believed to be allowable for the reason that they depend on an allowable base claim and for the additional elements they recite.

*The Rejection under 35 U.S.C. § 112*

Applicants respectfully traverse the rejection under 35 U.S.C. § 112 as being improper and as being administered in a manner adverse to the requirements of MPEP § 2173.05.

MPEP § 2173.05 provides for rejection on the "ground of multiplicity."

While the Examiner has given a rejection on the grounds of multiplicity, the Examiner has failed to establish a basis for the multiplicity rejection. The Examiner has failed to point out even one example of a pair of claims that are considered repetitive or multiplicative.

Applicants respectfully assert that the claims are not multiplicative or repetitive. Applicants draw the attention of the Examiner to the fact that in each remaining independent claim at least one limitation is recited that is not recited in any other independent claim.

A large number of claims does not *per se* provide a legitimate grounds for a multiplicity rejection. The large number of claims must result in actual confusion as to the subject matter claimed for a multiplicity rejection to be proper ("Examination of forty claims in a single application may be tedious work, but this is no reason for saying that the

invention is obscured by the large number of claims.” *In re Wakefield* 164 USPQ 636, cited in MPEP § 2173.05(n)). If the Examiner wishes to maintain the rejection under 35 U.S.C. § 112, the Examiner is respectfully requested to specifically point out the reasons why he believes the claims are unclear, rather than merely point out that the number of claims is large.

Further, as explained in the response of September 11, 2002, the large number of claims in the application resulted from the Examiner’s indication in an action dated June 11, 2002 that several dependent claims would be allowable if rewritten in independent form. The applicants responded to the Examiner’s indication of allowable subject matter by converting 16 dependent claims into independent form per the suggestion of the Examiner. Pursuant to text book claim drafting practice, the applicants submitted dependent claims relative to several of the independent claims, thus yielding a large number of claims. By signing the June 11, 2002 action, the Examiner had indicated that he had comprehensively examined, and had fully applied art to the subject matter of each and every one of the total of 17 independent claims submitted in the response of September 11, 2002. Accordingly, it is believed that the applicants response of September 11, 2002 imposed no further search burden on the Examiner (“We note that the claims were clear enough for the examiner to apply references against all of them in his first action,” *In re Wakefield*, cited in MPEP § 2173.05[n]).

Still further, the Examiner has applied MPEP § 2173.05 (n) in a manner that is adverse to the specific provisions of MPEP § 2173.05 (n), and has therefore prejudiced the application. MPEP § 2173.05 (n) recognizes that a multiplicity rejection under MPEP § 2173.05 (n) represents an unusual exception to an applicants otherwise free choice to define his invention. MPEP § 2173.05 (n) therefore outlines a specific series of steps which should be carefully followed to assure that an applicants rights are not abridged. MPEP § 2173.05(n) states:

If a rejection on multiplicity is in order the examiner should make a telephone call explaining that the claims are unduly multiplied and will be rejected on that ground. Note MPEP § 408. The examiner should request selection of a specified number of claims for purposes of examination.

If time for consideration is requested arrangements should be made for a second telephone call, preferable within three working days.

When claims are selected, a formal multiplicity rejection is made, including a complete record of the telephone interview, followed by an action on the selected claims.

When applicant refuses to comply with the telephone request, a formal multiplicity rejection is made. The applicant's reply to a formal multiplicity rejection of the examiner, to be complete, must either:

(A) Reduce the number of claims presented to those selected previously by telephone, or if no previous selection has been made to a number not exceeding the number specified by the examiner in the Office action, thus overcoming the rejection based upon the ground of multiplicity, or

(B) In the event of a traverse of said rejection applicant, besides specifically pointing out the supposed errors of the multiplicity rejection, is required to confirm the selection previously made by telephone, or if no previous selection has been made, select certain claims for purpose of examination, the number of which is not greater than the number specified by the examiner.

The Examiner has not taken any of the steps outlined in MPEP § 2173.05(n) for ensuring that an applicant is not unduly prejudiced by a multiplicity rejection. The Examiner did not telephone applicants attorney regarding the multiplicity rejection as specifically provided for in MPEP § 2173.05(n). Such a telephone interview would have allowed the applicants to orally respond to the prospective rejection, and possibly, convince the Examiner to refrain making the rejection. The Examiner also failed to provide applicant with "time for consideration" of the multiplicity rejection as is required by MPEP § 2173.05(n). Further, the Examiner failed to record "a complete record of the telephone interview" as is also required by MPEP § 2173.05(n). In addition, the Examiner failed to telephonically request selection of a specified number of claims, as stipulated in § 2173.05 (n). Because the Examiner failed to telephonically request a selection of claims, applicants are unable to respond as is set forth in § 2173.05 (n), paragraphs 8 and 9.

The Examiner's avoidance of the telephone interview requirement of MPEP § 2173.05(n) is taken as evidence that although the claims were voluminous they were nevertheless manifestly clear and substantially distinguished from one another.

Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully

FAIOLA  
Application No. 09/316,651

**PATENT**

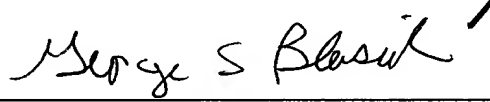
requests reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,

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